



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,128	10/04/2000	Mark A. Sibert	RSW9-2000-0066-US1	7290

7590 01/13/2004

Esther H. Chong, Esquire
Synnestvedt & Lechner LLP
2600 Aramark Tower
1101 Market Street
Philadelphia, PA 19107-2950

EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 01/13/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,128

Applicant(s)

SIBERT, MARK A.

Examiner

Doug Hutton

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,11-15,17-22,24 and 25 is/are rejected.
- 7) ☒ Claim(s) 4,10,16 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- the specification fails to mention the “reply” recited in Claims 17 and 18.

Claim Objections

Claims 4 and 10 are objected to because of the following informalities:

- based on Examiner’s understanding of the invention, the “data group” includes:
1) the standard information in a digital wallet, and 2) the mapping information used to convert ECML format to the proprietary format (see Figure 9A in Drawings). Claim 4, Line 3 indicates that a prefix is added “to each field identifier of the data fields of the data group.” Examiner believes this recitation is inaccurate. A prefix is not added to “each” (every) field identifier; rather, a prefix is added only to those field identifiers that are standard ECML field identifiers for the purpose of converting them into the proprietary format (see *Specification* – Page 13, Lines 4-26).

Claim 10 is objected to because of the following informalities:

- the term “add” in Line 2 should be amended to — includes adding — and the term “compare” in Line 3 should be amended to — comparing — so that the limitation reads more clearly.

Claim 13 is objected to because of the following informalities:

- the phrase “for receiving *the* form data” in Line 2 should be amended to — for receiving form data — because “form data” is not previously mentioned in the claim.

Claim 16 is objected to because of the following informalities:

- the phrase “the mapping information and” should be inserted between the terms “on” and “the” in Line 3 because the hash table is based on both the “mapping information” and the first data field pairs (see Specification – Page 11, Lines 18-24);
- the phrase “corresponding to the plurality of first data field pairs” in Line 4 should be deleted because the “key pairs” include the mapping information and does not correspond only to the first data field pairs;
- the term “first field names” in Line 6 should be amended to — key names — and the term “first field pairs” in Line 6 should be amended to — key pairs — because the prefix is added to the key names, not the first field names (see Specification – Page 12, Lines 13-15);

- the term “first field name” in Lines 6-7 should be amended to — key name — for the same reason previously indicated;
- the phrase “of the key names” in Line 7 should be amended to — other key name — because the “prefixed key name” is compared to all the other “key names” (see Specification – Page 12, Lines 17-19); and
- the term “the” (third occurrence) in Line 7 should be deleted so the limitation reads more clearly.

Claim 23 is objected to because of the following informalities:

- the phrase “the mapping information and” should be inserted between the terms “on” and “the” in Line 4 because the hash table is based on both the “mapping information” and the first data field pairs (see Specification – Page 11, Lines 18-24);
- the phrase “corresponding to the plurality of first data field pairs” in Line 5 should be deleted because the “key pairs” include the mapping information and does not correspond only to the first data field pairs;
- the term “first field names” in Line 7 should be amended to — key names — and the term “first field pairs” in Line 7 should be amended to — key pairs — because the prefix is added to the key names, not the first field names (see Specification – Page 12, Lines 13-15);
- the term “first field name” in Line 8 should be amended to — key name — for the same reason previously indicated;

Art Unit: 2178

- the phrase “of the key names” in Line 8 should be amended to — other key name — because the “prefixed key name” is compared to all the other “key names” (see Specification – Page 12, Lines 17-19); and
- the term “the” (first occurrence) in Line 10 should be deleted so the limitation reads more clearly.

Appropriate correction is required.

Drawings

Figures 1-4 should be designated by a legend such as — PRIOR ART — because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17, 18 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 17 and 24:

Claim 17 recites the limitation “wherein the third means generates a reply based on results of processing the plurality of second data field pairs, and *transmits the reply to the second means through the first means*” in Lines 1-3.

Examiner understands the “third means” to be the “form processing program (FPP),” the “second means” to be the “field name converting program (FNCP)” and the “first means” to be an “HTTP server” (see Specification – Page 9, Lines 14-17). As indicated below, Examiner is unsure what comprises the “reply” generated by the form processing program. Regardless of what exactly the “reply” is, nowhere in the description of the invention does Applicant mention how/why the FPP “transmits” the reply to the FNCP through the HTTP server.

Claim 24 is rejected using the same rationale.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 17, 18 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15:

The claim recites the limitation "wherein, prior to receiving the form data, the first means embeds the mapping information on the computer form" in Lines 1-2. This limitation is indefinite because it is unclear how the "first means" embeds mapping information on the computer form **before** it receives the form.

Applicant should amend the claim limitation to particularly point out and distinctly claim the "first means."

Claims 17 and 24:

The claim recites the limitation "wherein the third means generates a *reply* based on results of processing the plurality of second data field pairs" in Lines 1-2. This limitation is indefinite because it is unclear what comprises the "reply." Nowhere in the description of the invention does Applicant mention a "reply."

Applicant should amend the claim limitation to particularly point out and distinctly claim the "reply."

Claim 24 is rejected using the same rationale.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5, 7-9, 11, 13-15, 17, 18, 20-22 and 24 are rejected under 35

U.S.C. 102(e) as being anticipated by Bollay, U.S. Patent No. 6,457,009.

Claim 1:

Bollay discloses a method of translating the data structure of a data group pertaining to a computer form from a first format to a second format (see “Abstract” on Page 1), comprising the steps of:

- correlating data fields of the first format with data fields of the second format (see “Table II” in Column 4);
- identifying data fields from the data group corresponding to the first format (see “Table II” in Column 4); and
- replacing field identifiers of the identified data fields with field identifiers of the data fields of the second format based on the results of the correlating step (see Column 4, Line 13 through Column 5, Line 39 – the “field identifiers” of the generic form are replaced with the “actual names” used in the specific form).

Claim 2:

Bollay discloses the method of Claim 1, further comprising the step of:

- receiving, through a communication network, the data group and mapping information (see Column 2, Line 42 through Column 3, Line 25 and Table II in Column 4 – the “data group” is the generic form and the “mapping information” is shown in Table II, both of which are “received” through a “communication network”), the mapping information corresponding to the results of the correlating step (see Table II in Column 4).

Claim 3:

Bollay discloses the method of Claim 2, wherein, in the receiving step, the communication network includes the Internet and the computer form includes a web page (Column 1, Lines 11-21).

Claim 5:

Bollay discloses the method of Claim 1, further comprising the steps of:

- embedding the results of the correlating step on the computer form (the “results” are the translations shown in Table II, which are “embedded” on the generic form); and
- transmitting the embedded computer form to a user to fill out through a communication network (the generic form is transmitted to a user so that the user can fill out the form).

Claims 7-9 and 11:

These claims are for software that performs the method of Claims 1-3 and 5.

Thus, Bollay discloses every limitation in these claims using the same rationale.

Claim 13:

Bollay discloses a system for processing form data of a computer form (see “Abstract” on Page 1), the system comprising:

- first means for receiving form data of the computer form through a communication network (see Figure 1 and Column 3, Line 41 through Column 4, Line 10 – the “first means” receives the “form data” via the Internet), the form data including mapping information (see Table II in Column 4) and a plurality of first data field pairs, each of the first data field pairs including a first field name and a first field value (see Table I in Column 4);
- second means for communicating with the first means, the second means changing at least one of the first field names based on the mapping information, and thereby generating a plurality of second data field pairs (see Column 4, Line 13 through Column 5, Line 39 – the “second means” communicates with the “first means” and translates the “first field names” based on the “mapping information” and thus generates “second data field pairs”); and
- third means for communicating with the first means and processing the plurality of second field pairs (see Column 5, Line 41 through Column 6, Line 13 – the “third means” processes the “second field pairs”).

Claim 14:

Bollay discloses the system of Claim 13, wherein the communication network includes the Internet and the computer form includes a HTML form (Column 1, Lines 11-21).

Claim 15:

Bollay discloses the system of Claim 14, wherein, prior to receiving the form data, the first means embeds the mapping information on the computer form (the "mapping information" are the translations shown in Table II, which are "embedded" on the generic form) and transmits the computer form having the embedded mapping information to a user's computer through the communication network (the generic form is transmitted to a user so that the user can fill out the form), whereby the user's computer transmits the form data and the mapping information to the first means (upon completion of the generic form by the user, the user's computer transmits the form to the "first means").

Claim 17:

Bollay discloses the system of Claim 13, wherein the third means generates a reply based on results of processing the plurality of second data field pairs, and transmits the reply to the second means through the first means (as indicated in the above 112 rejection, Examiner is unsure what is being claimed; however, because Bollay discloses a form processing program (FPP), a field name converting program

Art Unit: 2178

(FNCP) and an HTTP server, it is Examiner's position that Bollay discloses every element of Claim 17).

Claim 18:

Bollay discloses the system of Claim 17, wherein the second means passes the reply received from the third means to the first means and then the first means transmits the reply through the communication network (as indicated in the above 112 rejection, Examiner is unsure what is being claimed; however, because Bollay discloses a form processing program (FPP), a field name converting program (FNCP) and an HTTP server, it is Examiner's position that Bollay discloses every element of Claim 18).

Claims 20-22 and 24:

These claims are for the method performed by the system recited in Claims 13-15, 17 and 18. Thus, Bollay discloses every limitation in these claims using the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 12, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bollay, U.S. Patent No. 6,457,009, in view of the admitted prior art (Admission).

Claim 6:

As indicated in the above discussion, Bollay discloses every element of Claim 1.

Bollay fails to disclose a method of translating the data structure of a data group pertaining to a computer form from a first format to a second format, wherein the first format is ECML format.

Admission discloses that ECML format was well-known in the art of electronic commerce. The ECML format was created for the purpose of standardizing field names used for online order forms on merchant Web sites. Using ECML format, information typically sought on an online order form was stored in a digital wallet. An online shopper had to input the information only once into said digital wallet, and thereafter the digital wallet was accessed to provide the stored information to each online order form, and automatically fill out said order form, whenever such data was requested. Such a mechanism enhanced the user's online shopping experience.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Bollay, so that the first format is ECML format for the purpose of facilitating the user's online shopping experience.

Claims 12, 19 and 25:

These claims are rejected using the same rationale used in the rejection for Claim 6.

Allowable Subject Matter

Claims 4, 10, 16 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 4 and 10:

The prior art fails to disclose or suggest a method of translating field names of a data group in a computer form used in electronic commerce from a first format to a second format, comprising the steps of:

- in the data group, establishing a mapping field comprising data field pairs, the data field pairs comprising standardized field names with a predetermined prefix and their corresponding proprietary field names;
- for the data group, identifying field names in the first format by adding a prefix to those field names that do not include a predetermined prefix and comparing the prefixed field names with the standardized field names of the mapping field in order to identify all field names of the data group that are in the first format; and

- converting the identified field names into the second format based on the mapping field.

Claims 16 and 23:

The prior art fails to disclose or suggest a method of processing form data of a computer form used in electronic commerce, comprising the steps of:

- receiving the form data through a communication network, the form data including mapping information and a plurality of first data field pairs, each of the first data field pairs including a first field name and a first field value;
- preparing a hash table based on the mapping information and the plurality of first data field pairs, the hash table comprising a plurality of key pairs, each of the key pairs including a key name and a key value;
- adding a prefix to at least one of the key names of the key pairs;
- determining if the prefixed key name matches any other key name;
- replacing the prefixed key name with the key value associated with the matching key name based on results of the determining step to generate second data field pairs; and
- processing the second data field pairs.

Art Unit: 2178

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kuwahara, U.S. Patent No. 6,202,072; Vanechanos, Jr. , U.S. Patent No. 5,884,309; and Gupta et al., U.S. Patent No. 6,199,079.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH
January 5, 2004

**HEATHER HERNDON
SUPERVISORY PATENT EXAMINER
TECH CENTER 2100**